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OFFICE OF PETITIONS

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PO Box 10395
Chicago, IL 60610

In re Application of
Paasche et al.
Application No. 09/714,739
Filed: November 16, 2000

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: DECISION GRANTING PETITION
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This decision is in response to Applicants' "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705" filed on Sept. 07, 2007 requesting that the Office adjust the PTA determination at the time of the mailing of the Notice of Allowance from 0 days to 0days.

Applicants' petition to correct PTA is **GRANTED-in Part**. The Office will adjust the PTA at the time of the mailing of the notice of allowance to reflect a determination of ZERO (0) days with 421 days of Office delay and 528 days of Office delay.

Applicant argues that the Office erred in the calculations of the PTA. The applicant argues that the Office first erred in failing to assess a 17 day delay in the submission of an IDS on April 7, 2006. The applicant asserts that the failure to enter the IDS into the PALM record lead to an incorrect PTA calculation.¹ In addition, the Applicants allege that the Office erred entering the date of the RCE submitted as February 9, 2007 rather than February 8, 2007.² Furthermore, Applicant assert that the reduction for the submission of the IDS on March 21, 2007 should be removed because applicant incorporated a statement pursuant to 37 CFR 1.704(d) that waives any reduction under 37 CFR 1.704(c)(8).

Applicant arguments as are persuasive to the extent indicated herein. First, the reduction of 17 days for the submission of an IDS on April 7, 2007 is accurate. The applicants did submit the IDS on April 7, 2007 as evidence on the file record. However, the PALM file history does not include the submission of the IDS on April 7, 2007. Accordingly, the PTA did not reduce the PTA for this event. Second, the Office did err in the entry of Feb. 9, 2007 as the date of the submission of the RCE. Record indicate that the submission was filed on Feb. 8, 2007 by express mail. Accordingly the reduction should have been 92 days rather than the 93 days assessed under 1.704(b). Finally, applicants assertion that the forty day reduction under 37 CFR 1.704(c)(8) should be removed because of the appellant waiver statement submitted under 37 CFR 1.704(d) with the IDS is NOT found persuasive because the applicant failed to submit the

¹It is noted that the Image File Wrapper (IFW) reflects the submission of the IDS on April 7, 2006.

²It is noted that the submission of the RCE was by express mail having label

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proper language in the waiver statement.³ Accordingly, the Office will not waive the 40-day reduction period. It is further noted that since applicants filed the RCE on Feb. 8, 2007 and not Feb. 9, 2007, then the reduction is 41 days rather than 40 days. Accordingly, based upon this decision, the Office will add $(17-1+1=17)$ 17 additional days of applicant delay.

After the mailing of this decision, the Office will forward the application to the Office of Patent Publications for a prompt issuance of the patent. Any delays pursuant to 37 CFR 1.702(b) or 1.702(a)(4) will be reflected in the issue notification letter that is mailed to applicant approximately three weeks prior to issuance of the application.

The Office has assessed the \$200.00 fee. No additional fees are required in deciding this petition matter.

Any questions concerning this decision should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration at 571-272-7757.

Kery A Fries

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

cc: Copy of Adjusted Pair Calculation

³It is noted that Applicant used the language “ was first cited in a foreign communication from a foreign patent office in a counterpart application” (emphasis added). Applicant needed to certify that each reference “was not cited in ANY foreign communication from a foreign patent office in a counterpart application.” The language has different meaning and prevents applicants from waiving IDS submission when applicant receives two communications identifying the same reference but applicant not submitting the waiver to state that the IDS submission was within 30 days of first cited communication citing that reference.